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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

LM01/0412

WILLIAM K WELLS  
KENYON AND KENYON  
1025 CONNECTICUT AVENUE N W  
WASHINGTON DC 20036

VINCENT, S	
ART UNIT	PAPER NUMBER

2765  
DATE MAILED:

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/227,406

Applicant(s)

MILLER, GEOFFREY MARC

Examiner

Steven F Vincent

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 January 1999.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 January 1999 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) \_\_\_\_\_.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

## Attachment(s)

- 14) ☒ Notice of References Cited (PTO-892)
- 15) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 16) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,3.
- 17) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 18) ☐ Notice of Informal Patent Application (PTO-152)
- 19) ☐ Other: \_\_\_\_\_.

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### DETAILED ACTION

1. Claims 1 to 29 are presented for examination.

#### *Drawings*

2. The drawings filed on January 8, 1999 are acceptable subject to correction of the informalities indicated on the attached "Notice of Draftperson's Patent Drawing Review," PTO-948. In order to avoid abandonment of this application, correction is required.

#### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 does not accomplish what preamble sets forth.

#### *Claim Rejections - 35 USC § 101*

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

*CLAIMS 1-12 ARE*

- EWS*
6. ~~Claim 1 is~~<sup>1</sup> rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. Claim 1 is not a practical application since this claim only lists the component parts without linkages to make up a practical application.

#### *Claim Rejections - 35 USC § 102*

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7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

8. Claims 1, 3, 5, 7, 9, 11 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Clark et al. (US 5,974,389), filed on March 1, 1996. Clark was cited on the second IDS submitted on February 1, 2000.

**Claim 1.**

A computer-based system for automating administrative procedures in a medical office, said system comprising:

a control module;

*Clark discloses a Database Management System and System Server in Figure 1.*

an administrator module in communication with said control module;

*Clark discloses Doctor's Computer in contact with System Server that contains Database Management System in Figure 1.*

a tape management module in communication with said control module; and

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*Clark discloses Transcriber's Computer in contact with System Server in Figure 1. Transcriber's computer is further disclosed on column 4, line 24, which talks of dictation apparatus.*

a database accessible by said administrator module and said tape management module, said database including patient information and provider information.

*Clark discloses database management system as part of the System Server in Figure 1. The System Server includes Patient Record Database and is connected to Doctor's Computer, Nurse's Computer, Transcriber's Computer and Insurance Administrator's Computer.*

**Claim 3.**

The computer-based system of claim 1, further comprising a provider module.

*Clark discloses several provider modules in Figure 1.*

**Claim 5.**

The computer-based system of claim 1, further comprising a management module.

*Clark discloses Data Base Management System in Figure 1.*

**Claim 7.**

The computer-based system of claim 1, further comprising a database management module.

*Clark discloses Data Base Management System in Figure 1.*

**Claim 9.**

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The computer-based system of claim 1, further comprising a report management module.

*Clark discloses Reporting Information Database module in Figure 1.*

**Claim 11.**

The computer-based system of claim 1, wherein said tape management module includes instructions for performing one or more tasks selected from a group consisting of: tracking location of transcription tapes; assigning tapes to transcriptionists; tracking transcribed reports; assigning medical records to reviewers; and tracking documents associated with transcription tapes.

*Clark discloses Transcriber's Computer in contact with System Server in Figure*

*1. Transcriber's computer is further disclosed on column 4, line 24, which talks of dictation apparatus.*

**Claim 12.**

The computer-based system of claim 1, further comprising a communications interface, said tape management module being configured to electronically receive files containing transcribed reports using said communications interface.

*Clark discloses interface to the Transcriber's computer in the paragraph starting on column 3, line 41. The computer operation is described in the paragraph on column 4, line 10.*

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9. Claim 13 and 19 to 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Lancelot et al (US 5,946,659). Lancelot was cited in the second IDS by the applicant submitted on February 1, 2000.

**Claim 13.**

A computer-implemented method for automating administrative procedures in a medical office, said method comprising the steps of:

maintaining an office automation system including a database containing provider information and patient information;

*Lancelot shows automation system in Fig. 1B with a description of the system in the paragraph starting on column 4, line 12.*

generating reports from the office automation system, automatically populating fields in the reports with information from the database where appropriate; and

*Lancelot discloses a database on column 6, line 50. Several reports are shown in Figures 10 to 12. In Figure 11, a choice list is shown which allows the user to populate the report with information from the database.*

supporting performance of one or more administrative tasks by an off-site service provider, including managing an electronic information exchange between the off-site service provider and the office automation system.

*Lancelot discloses off-site support computer in Fig. 1B.*

**Claim 19.**

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A storage medium containing a set of instructions for execution by a computer, the set of instructions serving to automate administrative tasks in a medical office, said set of instructions comprising instructions for:

maintaining an office automation system including a database containing provider information and patient information;

*Lancelot shows automation system in Fig. 1B with a description of the system in the paragraph starting on column 4, line 12.*

generating reports from the office automation system, automatically populating fields in the reports with information from the database where appropriate; and

*Lancelot discloses a database on column 6, line 50. Several reports are shown in Figures 10 to 12. In Figure 11, a choice list is shown which allows the user to populate the report with information from the database.*

supporting performance of one or more administrative tasks by an off-site service provider, including managing an electronic information exchange between the off-site service provider and the office automation system.

*Lancelot discloses off-site support computer in Fig. 1B.*

**Claim 20.**

The storage medium of claim 19, wherein said storage medium comprises a portable storage device.

*Lancelot discloses a central computer which includes a "disc drive memory unit" as shown on column 6, line 42. Although a portable storage device is not specifically*



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*disclosed, a disc drive memory unit in computers normally consists of a hard drive and some sort of "floppy" disc drive.*

**Claim 21.**

The storage medium of claim 19, wherein said storage medium comprises a memory of the computer.

*Lancelot discloses a central computer which includes a "primary memory unit 41, such as a random access memory unit" on column 6, line 39.*

10. Claims 22 to 29 are rejected under 35 U.S.C. 102(a) as being anticipated by MedicaLogic's Logicon and related products. MedicaLogic is disclosed in four MedicaLogic press releases dated: January 27, 1997, February 17, 1997, October 27, 1997 and November 10, 1997. MedicaLogic is also disclosed in a June 1996 article in Health Management Technology by Dunbrack and in a June 5, 1995 article in Network World of June 5, 1995 by Messmer.

**Claim 22.**

A computer-implemented subscription service for automating administrative procedures in a medical office, said subscription service comprising:

maintaining a database at a subscriber service center, said database containing information relating to a plurality of subscribers:

providing each of said subscribers with a computer-based office automation system configured to exchange data electronically with said subscriber service center;

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receiving at said subscriber service center a request for performance of an office administration task;

performing the requested office administration task at said subscriber service center; and

electronically transmitting information relating to performance of the office administration task back to said computer-based office automation system.

*These features are shown starting in the first paragraph on the second page of the February 17, 1997 MedicaLogic press release which describes the features of Logician 4.2. Links to any clinical data repository, electronic links and administrative tasks are disclosed. Database functionality is also disclosed in the Network World article of June 5, 1995 on the second column.*

*MedicaLogic discloses subscription service in the Dunbrack article. On page 34, first column, MedicaLogic integrated Logicon with Reynolds and Reynolds' R/2000 product. On the same page on the next column, it was disclosed that Reynolds and Reynolds' R/2000 has been implemented in almost 100 service bureaus.*

**Claim 23.**

The computer-implemented subscription service of claim 22, wherein the requested office administration task comprises transcription of a dictation tape.

*MedicaLogic discloses transcription in the January 27, 1997 press release.*

**Claim 24.**

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The computer-implemented subscription service of claim 23, wherein the information relating to performance of the office administration task comprises a computer file containing a transcription of the dictation tape.

*MedicaLogic discloses transcription in the January 27, 1997 press release and the methodology is explained in the bottom of the first page and top of the second page.*

**Claim 25.**

The computer-implemented subscription service of claim 22, wherein the information relating to performance of the office administration task comprises status information.

*This feature is disclosed in the February 17, 1997 MedicaLogic press release on the third full paragraph of the second page.*

**Claim 26.**

The computer-implemented subscription service of claim 22, further comprising the step of generating a report from the computer-based office automation system using the information relating to performance of the office administration task.

*This feature is disclosed in the February 17, 1997 MedicaLogic press release on the third full paragraph of the second page.*

**Claim 27.**

The computer-implemented subscription service of claim 22, wherein the requested office administration task comprises chart preparation.

*Electronic charts are disclosed by MedicaLogic in the January 27, 1997 press release in fourth paragraph.*

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**Claim 28.**

The computer-implemented subscription service of claim 22, wherein the requested office administration task comprises report generation.

*Reports are disclosed by MedicaLogic in the November 10, 1997 press release in the fourth paragraph, which discusses decision support.*

**Claim 29.**

The computer-implemented subscription service of claim 22, wherein the requested office administration task comprises forms generation.

*This feature is disclosed by MedicaLogic in the Network World article of June 5, 1995.*

**Claim Rejections - 35 USC § 103**

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

*CLAIMS 2, 4, 6, 8 AND 10 ARE*

*EWS*  
12. ~~Claim 2 is~~ rejected under 35 U.S.C. 103(a) as being unpatentable over Clark as applied to claim 1 above, and further in view of Ornstein et al. Ornstein in the November/December 1998 article in Family Practice Management entitled "Computerized Patient Record Systems: A Survey of 28 Vendors", rates the various computerized patient record systems.

**Claim 2.**

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The computer-based system of claim 1, wherein said administrator module includes instructions for providing access to one or more reports selected from a group consisting of, departmental management reports; data availability reports; provider workload reports; transcription tape status reports; medical record review status reports; and chart location reports.

*Clark discloses a computerized medical records system as shown in claim 1 above, but does not disclose the specific reports shown above. Ornstein discloses case management systems features on pages 3-5. It would have been obvious to add the specific features from Ornstein to Clark to improve functionality.*

**Claim 4.**

The computer-based system of claim 3, wherein said provider module includes instructions for performing one or more tasks selected from a group consisting of, providing access to a list of outstanding reports; prioritizing outstanding reports based on workload age; transferring files containing reports to portable storage media; and distributing incoming reports to providers.

*Clark discloses a computerized medical records system as shown in claim 1 above, but does not disclose the specific reports shown above. Ornstein discloses case management systems on page 4. It would have been obvious to add the specific features from Ornstein to Clark to improve functionality.*

**Claim 6.**

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The computer-based system of claim 5, wherein said management module includes instructions for providing access to one or more reports selected from a group consisting of: departmental chart distribution; appointment listings; identification of charts requiring action; identification of no-show patients; database maintenance statistics; and system backup statistics.

*Clark discloses a computerized medical records system as shown in claim 1 above, but does not disclose the specific reports shown above. Ornstein discloses case management systems features on pages 3-5. It would have been obvious to add the specific features from Ornstein to Clark to improve functionality.*

**Claim 8.**

The computer-based system of claim 7, wherein said database management module includes instructions for performing one or more tasks selected from a group consisting of: archiving aged records; purging outdated records; transmitting notifications of required actions; managing flow of files into and out of the medical office; maintaining one or more tables containing employee information, provider information, and report types; processing data entry input; and populating tables with data entry input.

*Clark discloses a computerized medical records system as shown in claim 1 above, but does not disclose the specific reports shown above. Ornstein discloses case management systems features on pages 3-5. It would have been obvious to add the specific features from Ornstein to Clark to improve functionality.*

**Claim 10.**

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The computer-based system of claim 9, wherein said report management module includes instructions for performing one or more tasks selected from a group consisting of: populating report forms with patient information; generating headings and standard text entries customized by provider; generating letterhead and signature lines customized by provider; generating boilerplate language required for particular types of reports; distributing reports; printing reports; and generating and distributing forms in batch mode.

*Clark discloses a computerized medical records system as shown in claim 1 above, but does not disclose the specific reports shown above. Ornstein discloses case management systems features on pages 3-5. It would have been obvious to add the specific features from Ornstein to Clark to improve functionality.*

13. Claim 14 to 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lancelot as applied to claim 13 above, and further in view of Jachmann et al (US 5,146,439). Jachmann discloses records management system with dictation/transcription capability

**Claim 14.**

The computer-implemented method of claim 13, wherein said step of supporting performance of one or more administrative tasks by an off-site service provider comprises supporting off-site tape transcription.

*Lancelot discloses a computer-implemented method for automating administrative procedures in a medical office as shown in claim 13 above with an off-*

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*site service provider, but does not disclose off-site tape transcription. Jachmann discloses off-site tape transcription as shown in column 3, line 12 and medical office uses are disclosed in the abstract. It would have been obvious to combine Lancelot and Jachmann since the addition of off-site transcription is disclosed by Jachmann and would make Lancelot's application more useful.*

**Claim 15.**

The computer-implemented method of claim 14, further comprising the step of maintaining information relating to a current workload for each of a plurality of off-site transcriptionists.

*Lancelot discloses a computer-implemented method for automating administrative procedures in a medical office as shown in claim 13 above with an off-site service provider, but does not disclose off-site tape transcription. Jachmann discloses off-site tape transcription as shown in column 3, line 12 and priority assignment in Fig. 2A. It would have been obvious to combine Lancelot and Jachmann since the addition of off-site transcription is disclosed by Jachmann and would make Lancelot's application more useful.*

**Claim 16.**

The computer-implemented method of claim 15, further comprising the step of assigning a transcription tape to an off-site transcriptionist based upon the current workload information.



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*Lancelot discloses a computer-implemented method for automating administrative procedures in a medical office as shown in claim 13 above with an off-site service provider, but does not disclose off-site tape transcription. Jachmann discloses off-site tape transcription as shown in column 3, line 12 and priority assignment in Fig. 2A. It would have been obvious to combine Lancelot and Jachmann since the addition of off-site transcription is disclosed by Jachmann and would make Lancelot's application more useful.*

**Claim 17.**

The computer-implemented method of claim 14, further comprising the step of receiving an electronic transmission of a transcribed report from an off-site transcriptionist.

*Lancelot discloses a computer-implemented method for automating administrative procedures in a medical office as shown in claim 13 above with an off-site service provider, but does not disclose off-site tape transcription. Jachmann discloses off-site tape transcription as shown in column 3, line 12 and methods for sending transcribed report from an off-site transcriptionist are shown in Fig. 2B. It would have been obvious to combine Lancelot and Jachmann since the addition of off-site transcription is disclosed by Jachmann and would make Lancelot's application more useful.*

14. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lancelot as applied to claim 13 above, further in view of Jachmann, and further in view

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of Kerrigan. Kerrigan discloses in an article in Computer in Healthcare of December 1987 how hospitals are using services such as transcription to make a profit.

**Claim 18.**

The computer-implemented method of claim 13, wherein said method is provided as a subscription service.

*Lancelot discloses a computer-implemented method for automating administrative procedures in a medical office as shown in claim 13 above with an off-site service provider, but does not disclose off-site tape transcription. Jachmann discloses off-site tape transcription as shown in column 3, line 12 and medical office uses are disclosed in the abstract, but does not disclose payment. Kerrigan discloses how Piedmont Hospital was charging doctors for transcription services in 1987 as shown in the first column of page 36. It would have been obvious to combine Lancelot, Jachmann and Kerrigan since the addition of off-site transcription is disclosed by Jachmann and would make Lancelot's application more useful and payment is a necessary function of any business service.*

**Conclusion**

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

An article by the Computer-based Patient Record Institute entitled "Computer-based Patient Record System Description of Functionality" of August 1996 discloses features of such as system.

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Family Practice Management released an earlier survey of computerized record systems in February 1996 .

Evans (US 5,924,074), filed on September 27, 1996, discloses an electronic medical records system

Ross, Jr. et al (US 5,823,948), filed on July 8, 1996, discloses medical records system.

Debusk et al (US 5,994,937), filed on November 7, 1997, discloses a modular health care information system.

Lavin et al. (US 5,772,585), filed on August 30, 1996, discloses a patient medical records system.

Chaco et al (US 5,822,544), filed on April 20, 1995, discloses a patient care and communication system.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven F Vincent whose telephone number is 703-305-9694. The examiner can normally be reached on M- F 8:30 am to 6:00 pm with first Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan MacDonald can be reached on 703-305-9708. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-1396 for regular communications and 703-308-1396 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-3900.

Steven F. Vincent  
April 10, 2000

A handwritten signature in cursive script, appearing to read "Eric W. Stamber".

ERIC W. STAMBER  
PRIMARY EXAMINER